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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91216969
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re: U.S. Trademark Application Serial No. 86/127,398

Mark: SEBELA

Filing Date: November 22, 2013

Publication Date: April 22, 2014

FOREST LABORATORIES, LLC,)	
)	
Opposer,)	Opposition No.: 91216969
)	
v.)	
)	
SEBELA INTERNATIONAL LIMITED,)	
)	
Applicant.)	

**SEBELA’S RULE 56(D) RESPONSE TO
FOREST’S MOTION FOR SUMMARY JUDGMENT**

Pursuant to Rule 56(d) of the Federal Rules of Civil Procedure and T.B.M.P. § 528.06, Sebela International Limited (“Sebela” or “Applicant”) respectfully responds to the motion for summary judgment (the “Motion”) filed by Forest Laboratories, LLC (“Forest” or “Opposer”) on March 31, 2015. Sebela respectfully submits that it cannot currently present facts essential to support its opposition to Forest’s Motion. Therefore, discovery should be permitted into each of the issues set forth below, and Forest’s Motion should be denied.

I. PRELIMINARY STATEMENT

Forest’s Motion is at best premature, filed nearly two (2) months before the scheduled close of discovery, and is at worst an attempt to capitalize on newly-introduced evidence, unsubstantiated “facts”, and misrepresentations of material fact refuted by the public records of the USPTO and TTAB, all while depriving Sebela of any proper opportunity to test Forest’s proof. (See Declaration of Ashish D. Patel, at ¶ 2 (Attachment “1” hereto)). In any case, the present procedural posture presents a classic scenario warranting relief under Rule 56(d).

Forest contends that Sebela's application for the SEBELA mark, for "[m]edicated and pharmaceutical preparations, both prescription and over-the-counter, for use in dermatology; and, medicated and pharmaceutical preparations, both prescription and over-the-counter, for use in gastroenterology" in Class 5, Serial No. 86/127,398 (the "Application"), should be refused because of an alleged likelihood of confusion with Forest's SAVELLA mark, for "pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders" in Class 5, and its "Savella and Design" mark for associated Class 16 and 44 goods and services (collectively, the "SAVELLA Marks"). Sebela steadfastly denies this assertion and respectfully submits that its opposition to the Motion will be amply developed through discovery.

II. ARGUMENT AND CITATION TO AUTHORITY

Federal Rule of Civil Procedure 56(d) and § 528.06 of the Trademark Trial and Appeal Board Manual of Procedure provide that:

If a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may:

- (1) defer considering the motion or deny it;
- (2) allow time to obtain affidavits or declarations to take discovery; or
- (3) issue any other appropriate order.

Fed. R. Civ. P. 56(d); T.B.M.P. § 528.06. Rule 56(d)¹ functions as a "safeguard" against depriving the party opposing summary judgment of the "discovery needed to place at issue material factual questions in opposition to the motion." *Opryland USA, Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 852 (Fed. Cir. 1992) (citing *Celotex v. Catrett*, 477

¹ Former subdivision (f) of Fed. R. Civ. P. 56 has been carried forward by the 2010 amendments to the Federal Rules of Civil Procedure as subdivision (d). Consequently, the reference to Fed. R. Civ. P. 56(f) in 37 CFR § 2.127(e)(1) is to be read as a reference to present Fed. R. Civ. P. 56(d).

U.S. 317, 326 (1986) [Rule 56(d) provides nonmovants with protection from being “railroaded” by premature summary judgment motions], *National Life Ins. Co. v. Solomon*, 529 F.2d 59, 61 (2nd Cir. 1975) [summary judgment is improper when the opposing party has yet to exercise pretrial discovery]).

Thus, when the discovery sought is reasonably directed to “facts essential to justify the party’s opposition,” such discovery “**must** be permitted or summary judgment refused.” *Opryland*, 970 F.2d at 852 (emphasis added). “This is especially true if the information sought is largely within the control of the party moving for summary judgment.” *Arden Savoy Partners LLC v. Savoy Hotel Ltd.*, No. 40,406, 2003 TTAB LEXIS 337, at *9 (T.T.A.B. 2003) (citing *Orion Group, Inc. v. The Orion Insurance Company P.L.C.*, No. 79, 009, 12 U.S.P.Q.2d 1923, 1925 (T.T.A.B. 1989). Moreover, “it is well settled that the granting of a motion for summary judgment is inappropriate where the responding party has been denied discovery needed to enable it to respond to the motion.” *Orion Group, Inc.*, 12 U.S.P.Q.2d at 1924 (citing *Dunkin’ Donuts of America, Inc. v. Metalurgical Exoproducts Corp.*, 840 F.2d 917, 6 U.S.P.Q.2d 1026 (Fed. Cir. 1988)).

Here, evidence needed by Sebela to demonstrate the existence of multiple genuine issues of material fact for trial resides squarely within Forest’s possession, custody or control. However, the filing of Forest’s Motion necessarily suspended discovery prior to its scheduled close², and, thus, absent the Board’s grant of the relief requested herein, Sebela will be deprived of evidence required to properly oppose Forest’s Motion and to demonstrate the existence of

² Discovery was suspended, in accordance with Trademark Rule 2.127(d), following Forest’s filing of its Motion. *See* 37 C.F.R. § 2.127(d) (“When any party files a motion . . . for summary judgment . . . the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion . . .”).

numerous genuine issues of material fact relevant to several *DuPont* factors³. (See Patel Declaration at ¶ 3)

Sebela respectfully requests that it be permitted to take discovery on the following pertinent issues:

A. Similarity or Dissimilarity and Nature of the Goods or Services

For purposes of determining the full scope of the parties' goods, the Board looks to the goods as identified in the application and the cited registration. *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990); *In re Trivascular, Inc.*, No. 77941535, 2012 TTAB LEXIS 456, at *5 (T.T.A.B. 2012); *In re E.I. Du Pont*, 476 F.2d at 1361 (in testing for a likelihood of confusion, "the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use" must be considered). However, even where the registrations suggest that products similar to the goods of both applicant and registrant may emanate from a single source, the Board also may consider evidence submitted by the applicant to demonstrate the nature of the goods. *See in re*

³ *See, In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) establishing a 13-factor test for determining whether there is a likelihood of confusion supporting the Board's refusal to register a trademark. ("In testing for likelihood of confusion . . . the following, when of record, must be considered: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound connotation and commercial impression. (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. (3) The similarity or dissimilarity of established, likely-to-continue trade channels. (4) The conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark). (10) The market interface between applicant and the owner of a prior mark (11) The extent to which applicant has a right to exclude others from use of its mark on its goods. (12) The extent of potential confusion, i.e., whether *de minimis* or substantial. (13) Any other established fact probative of the effect of use.").

Trivascular, 2012 TTAB LEXIS 456, at *13 (finding this factor to favor applicant even where both applicant's and registrant's goods were implantable medical devices, as "[s]uch goods [could] not substitute for each other or be used together . . ." and "nothing in the record indicates that the parties' respective goods are more closely related to each other than they would be to other medical products.").

Moreover, simply because the products at issue are pharmaceuticals does not require a finding of similarity. *See Byk-Gulden, Inc. v. Trimen Laboratories, Inc.*, 211 U.S.P.Q. 364, 368, 1981 TTAB LEXIS 67, at *12 (T.T.A.B. 1981) ("Here, although it is clear that the products of the respective parties are related, both being 'pharmaceuticals,' it is equally clear that they are not the same, either in their composition or purpose.").

Here, in support of its Motion, and in support of its contention that the parties' respective goods are related, Forest repeatedly misrepresents material facts to the Board; namely: (1) that U.S. Registration No. 3,658,661, for the SAVELLA mark, covers pharmaceutical preparations for the treatment of "neuropathic pain disorders" in Class 5⁴; (2) that the SAVELLA mark has been in continuous and actual use in the United States on or in connection with such pharmaceutical preparations for the treatment of "neuropathic pain disorders" since April 24, 2009⁵; (3) that the SAVELLA mark is used on pharmaceutical preparations for the treatment of neuropathic pain disorders"⁶, and (4) that Forest's Class 5 registration for SAVELLA covers pharmaceutical preparations for the treatment of "neuropathic pain disorders"⁷. (*See Patel Declaration at ¶ 4*).

⁴ *See, e.g.*, Motion at pp. 1, 2.

⁵ *See, e.g.*, Motion at pp. 2, 3, 18.

⁶ *See, e.g.*, Motion at pp. 1, 2, 13, 15, 20.

⁷ *See, e.g.*, Motion at pp. 1, 2, 13, 15, 20.

However, on July 21, 2014 (approximately one (1) month after initiating this Opposition), Forest **expressly and permanently deleted** “neuropathic pain disorders” from its description of goods in U.S. Registration No. 3,658,661, in a Combined Declaration Under Section 8 & 15 filed in connection therewith – and thus statutorily declared that the SAVELLA mark was no longer in use on or in connection with such goods and that the SAVELLA registration no longer covered such goods. (*See* Patel Declaration at ¶ 5; *and see* Exhibits A and B thereto). Unfortunately, Forest failed to advise the Board of this most salient fact, and instead elected to pursue this Opposition and to premise various arguments in its Motion on these several misrepresentations of material fact, particularly those directed to purported similarity between the parties’ respective goods.⁸

Discovery into the facts concerning the specific goods on which Forest actually uses its SAVELLA mark is required, as it is fully relevant to an evaluation of the similarity or dissimilarity and nature of the parties’ respective goods, and thus to the likelihood of confusion analysis. (*See* Patel Declaration at ¶ 6). Forest’s misrepresentations as to the scope of its registration and actual use of its SAVELLA mark further compound the need for discovery into the facts and evidence upon which Forest premises its arguments of similarity or relatedness of the parties’ respective goods. (*Id.*). Such evidence is indisputably within Forest’s possession, and the requested discovery is required by Sebela to demonstrate the existence of genuine issues of material fact as to this *DuPont* factor. (*Id.*).

Moreover, in addition to revealing Forest’s actual goods and services,⁹ it is believed that such discovery will further reveal that the SAVELLA mark is not used with a variety of goods

⁸ *See, e.g.*, Motion at pp. 13-15.

⁹ It is believed that discovery will further reveal that Forest is not using the “Savella and Design” mark (U.S. Registration No. 3,761,078) in connection with any Class 16 or 44 goods or services

and services -- as Forest contends¹⁰ -- but rather a single, specific product with a specific purpose and nature, advertised and promoted by Forest in its printed materials (Class 16) and on its dedicated website (Class 44), with no ability or opportunity to be confused with Sebela's products. (*Id.* at ¶ 7). Here again, relevant evidence is within Forest's possession, and the requested discovery is required by Sebela to demonstrate the existence of genuine issues of material fact as to Forest's contention. (*Id.*).

Furthermore, Forest's unsupported and conclusive allegations that the sale of the parties' respective goods under their respective marks presents risks of "danger"¹¹, "cross-prescription"¹², "accidental substitution"¹³ or "serious consequences"¹⁴ must be tested through discovery (particularly in view of Forest's misrepresentations of material fact, as addressed above), and through which Sebela anticipates that Forest's contentions will be exposed as unfounded. (*Id.* at ¶ 8). In particular, Sebela requires discovery into facts and evidence pertaining to (1) Forest's actual goods and services, and the nature and purpose of the goods and services (including, for example, the actual scope of use of Forest's SAVELLA Marks/registrations on what appears to be a single product for a single specific purpose), (2) Forest's contentions regarding the sophistication of the doctors or other specialists prescribing or dispensing the parties' respective goods, (3) the actual manner in which Forest's goods are

pertaining to "neuropathic pain disorders", and that this design mark is only used in connection with the advertisement and promotion of Forest's (Class 5) SAVELLA "fibromyalgia" product, via its printed materials (Class 16) and its dedicated website (Class 44).

¹⁰ See Motion at pp. 20, 21.

¹¹ See Motion at pp. 1, 16, 21.

¹² See Motion at p. 2.

¹³ See Motion at p. 16.

¹⁴ See Motion at pp. 21.

prescribed, dispensed or used, (4) the inability of patients to “choose” between the parties’ respective goods, and (5) the actual consequences of any purported mistakes in view of the nature and purpose of the parties’ respective goods. (*Id.*). Evidence pertaining to the foregoing, and upon which Forest has premised its arguments, resides in Forest’s possession. Discovery into such facts and evidence is required in order to enable Sebela to demonstrate the dissimilarity between the parties’ respective goods, and thus the existence of genuine issues of material fact as to this *DuPont* factor, and, ultimately, that this factor favors Sebela, not Forest. (*Id.*).

B. Similarity or Dissimilarity of the Marks In Their Entireties

In testing for likelihood of confusion, the similarity or dissimilarity of the **marks in their entirety** as to appearance, sound, connotation and commercial impression, must be considered. *See, In re E.I. Du Pont*, 476 F.2d at 1361. In comparing the marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Sigma-Tau Industrie Farmaceutiche Riunite S.p.A v. SigmaPharm Laboratories, LLC*, Nos. 91196802, 91196807, 2015 TTAB LEXIS 42, at *75 (T.T.A.B. 2015) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 U.S.P.Q.2d 1713, 1721 (Fed. Cir. 2012)). Where “the dissimilarities in appearance, sound, connotation and commercial impression outweigh the similarities,” this *DuPont* factor weighs against a likelihood of confusion. *Id.* at *80.

The Federal Circuit “has found mark dissimilarity when the words are spelled differently.” *Citigroup, Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1350 (Fed. Cir. 2011) (finding the “T” misspelling in “CITI” to be distinctive) (citing *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1374-75 (Fed. Cir. 1998) (finding mark

dissimilarity between CRISTAL and CRYSTAL CREEK). Moreover, “[e]ven where the marks at issue are identical, or nearly identical, the Board has found that differences in connotation can outweigh visual and phonetic similarity.” *Coach Services, Inc.*, 668 F.3d at 1368 (citing *Blue Man Prods. Inc. v. Tarmann*, No. 91154055, 75 U.S.P.Q.2d 1811, 1820-21 (T.T.A.B. 2005) (finding that BLUE MAN GROUP “has the connotation of the appearance of the performers” and that applicant’s BLUEMAN mark “has no such connotation for cigarettes or tobacco. Thus, the marks differ in their connotations and commercial impressions.”).

At the outset, Forest’s Motion introduces the testimony of Dr. Lisa Davidson¹⁵ who opines, *inter alia*, that English speakers will pronounce the marks identically. However, Dr. Davidson has **not** previously been disclosed as an expert, and as a consequence of this and the need for relevant discovery outlined in its motion, Sebela cannot yet determine the necessity of taking the deposition of this newly-identified expert. (*See* Patel Declaration at ¶ 9).

Additionally, Forest argues that the parties’ marks are “virtually identical,”¹⁶ including as to meaning¹⁷, but provides no explanation and presents no evidence to support its allegation that the marks are similar in meaning. Indeed, there is **no** evidence in the record regarding the meaning of SAVELLA. As such, Sebela requires discovery from Forest directed to the connotation ascribed to the SAVELLA mark, and the connotation that Forest purports to ascribe to Applicant’s SEBELA mark. (*Id.* at ¶ 10). Sebela expects that this discovery will demonstrate significant dissimilarities in connotation between the parties’ respective marks, and, **viewing the marks in their entireties** (including the distinct visual and phonetic dissimilarities therebetween), that there exist genuine issues of material fact as to this *DuPont* factor. (*Id.*).

¹⁵ *See* Motion at p. 9.

¹⁶ *See* Motion at p. 8.

¹⁷ *See* Motion at p. 12.

Ultimately, Sebela anticipates that discovery will demonstrate this *DuPont* factor favors Sebela, not Forest. (*Id.*). Manifestly, the evidence pertaining to the connotation Forest would ascribe to its own mark and to Sebela's mark would reside squarely within Forest's possession, custody and control. (*Id.*).

C. The Number and Nature of Similar Marks in Use on Similar Goods

Forest claims there is “no evidence” of third-party use of marks similar to SAVELLA on goods or services similar to the SAVELLA marks.¹⁸ Despite the gross dissimilarities between Forest's and Sebela's respective goods, it appears that Forest's position is that *any* Class 5 good is “similar” to Forest's specific Class 5 good, and that, thus, there are no marks in any pending application or registration under Class 5 similar to the SAVELLA mark. But Forest knows that this is not true.

Forest has neglected to advise the Board, yet again, of material facts; namely: (a) that Forest previously sought to oppose, but withdrew *with prejudice* its opposition of, the REVELLA mark (U.S. Trademark Application No. 85/417,711; Opposition No. 91206078) based on Forest's SAVELLA Marks, and in which opposition Forest opposed all Class 5 goods of the REVELLA mark (*i.e.*, “diagnostic agents, preparations and substances for medical purposes; diagnostic preparations for medical and veterinary use; diagnostic reagents for medicinal use; medical diagnostic reagents”), and argued that “[t]he SAVELLA Marks and the Proposed Mark are very similar in ‘sight, sound, and meaning’” and that “[t]he goods and services described in Applicant's application are closely related to products and services offered by Opposer under the SAVELLA Marks such that consumer confusion is likely to result.” However, Forest withdrew *with prejudice* its opposition of the REVELLA mark, and permitted

¹⁸ See Motion at pp. 18-19.

the REVELLA mark/application to proceed unhindered in Class 5.¹⁹ (*See* Patel Declaration at ¶ 11; *and see* Exhibits C-F thereto).

Discovery is needed to uncover the facts and evidence surrounding any and all of Forest's prior oppositions of any third-party marks based on a likelihood of confusion with Forest's SAVELLA Marks, including Forest's decisions to oppose or to withdraw any such oppositions, any underlying litigations or settlements between those parties (or any other parties) and Forest concerning alleged likelihood of confusion of those parties' respective marks and Forest's SAVELLA Marks, any and all agreements, settlement agreements, consent to register agreements, or consent to use agreements therebetween, and, further, Forest's knowledge of any other third-party uses of, and pending applications or registrations for, marks that Forest deems similar to its SAVELLA Marks and which are used in connection with goods/services that Forest deems similar or related to Forest's SAVELLA goods/services, as well as any actions or inactions taken by Forest based on such knowledge. (*Id.* at ¶ 12). Such discovery is further germane to each of the *DuPont* factors at issue here, including the similarity or dissimilarity of the parties' respective marks and goods, and the alleged fame of Forest's SAVELLA Marks. (*Id.*).

¹⁹ Forest also opposed the AVELLA INC. and AVELLA HEALTH VIA EXCELLENCE marks (U.S. Trademark Application Nos. 85/606,899 and 85/618,429, respectively; Opposition No. 91209923) based on a likelihood of confusion with Forest's SAVELLA Marks, and wherein Forest opposed all classes, including the Class 5 goods directed to "drug delivery agents consisting of compounds that facilitate delivery of a wide range of pharmaceuticals; pharmaceutical preparations and substances for the treatment of infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, obesity and cognitive disorders; pharmaceutical preparations and substances for the treatment of viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, psychiatric and immune system related diseases and disorders; pharmaceutical preparations for the treatment of eye diseases and conditions". Amendments made to the description of goods and services in the applications ultimately led to Forest withdrawing the opposition with prejudice. (*See* Patel Declaration at fn. 12; *and see* Exhibits G-K thereto).

Once again, facts and evidence pertaining to the foregoing are within Forest's possession, custody or control, and the requested discovery is required by Sebela to demonstrate the existence of genuine issues of material fact as to this *DuPont* factor, and, ultimately, that this factor favors Sebela, not Forest. (*Id.*).

D. The Sophistication of Purchasers

For a likelihood of confusion to exist, "it must be based on confusion of some relevant person, i.e., a customer or user, and there is always less likelihood of confusion where goods are expensive and purchased and used by highly specialized individuals after careful consideration." *In re Inspired Technologies, Inc.*, No. 77272899, 2011 TTAB LEXIS 15, at *11-*12 (T.T.A.B. 2011) (quoting *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 786, 791 (1st Cir. 1983)). Moreover, even if pharmaceuticals are subject to a doctrine of greater care than other products, this may not necessarily apply to all drugs, and in particular, those not used in "life-or-death" situations. *See Horphag Research Limited v. Freelif International, LLC*, No. 102,797, 1999 TTAB LEXIS 461, at *7 (T.T.A.B. 1999) ("Without entering into the debate over the correctness of a 'doctrine of greater care' for pharmaceuticals, it seems clear to us that mistakes between nutritional supplements do not carry the same life-and-death risks as can mistakes between ethical pharmaceuticals.").

Here, although Forest argues (without citing any evidence) that doctors or pharmacists may confuse the parties' respective prescription products,²⁰ Sebela believes that discovery will demonstrate that, in addition to having distinctly different natures and purposes, the parties' respective products will be prescribed by doctors specializing in entirely separate and distinct disciplines of medicine, which will, in turn, govern how the parties' respective products are or

²⁰ See Motion at pp. 16-18.

will be prescribed, administered and used. (*See* Patel Declaration at ¶ 13). Sebela respectfully requests that it be permitted to develop, through discovery into these issues and into the bases of Forest’s arguments, these important distinctions. (*Id.*). Here again, relevant facts and evidence upon which Forest may rely in support of its argument may be within the possession of Forest, and discovery thereof is required to enable Sebela to demonstrate genuine issues of material fact as to this *DuPont* factor. (*Id.*).

E. Variety of Goods on which a Mark is Used or Not Used

Although Forest argues that it uses the SAVELLA mark “on a variety of goods and services,”²¹ Sebela expects that discovery will reveal this conclusory allegation as false. (*See* Patel Declaration at ¶ 14). Given that Forest deleted “neuropathic pain disorders” from the goods description of its registration, it is believed that discovery will demonstrate that the SAVELLA mark is limited to a single, specific product for the treatment of fibromyalgia, which is advertised by Forest using its printed materials (Class 16) and its dedicated website (Class 44). (*Id.*). This, however, is a far cry from “a variety” of goods and services. Discovery is required in order to enable Sebela to demonstrate the existence of a genuine issue of material fact as to this *DuPont* factor, and, ultimately, that this factor favors Sebela, not Forest. (*Id.*).

F. The Alleged Fame of Forest’s Mark

A famous mark has extensive public recognition and renown. *Biotab Nutraceuticals, Inc. v. Life Smart Labs, Inc.*, No. 92052031, 2012 TTAB LEXIS 377, at *8 (T.T.A.B. 2012) (citing *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 1371, 63 U.S.P.Q.2d 1303, 1305 (Fed. Cir. 2002), *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327-28, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000), *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 353, 22

²¹ *See* Motion at p. 20.

U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992)). Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, “by the length of time those indicia of commercial awareness have been evident,” widespread critical assessments, and through notice by independent sources of the products identified by the marks. *Bose Corp.*, 63 U.S.P.Q.2d at 1305-1306, 1309.

“Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary . . .” *Biotab*, 2012 TTAB LEXIS 377, at *8-*9 (citing *Bose Corp.*, 63 U.S.P.Q.2d at 1309); *see also RaceTrac Petroleum, Inc v. ETW Corp.*, No. 91117623, 2004 TTAB LEXIS 311, at *19-*21 (T.T.A.B. 2004) (although opposer had used mark continuously, sales figures of over \$240 million for a single year made through 140 stores in a 12 to 13 state area did not “suffice to show even regional or niche fame . . . much less that the . . . marks are famous nationwide or substantially so as alleged by opposer.”); *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, No. 91160856, 82 U.S.P.Q.2d 1901, 1904 (T.T.A.B. 2007) (“[A]lthough plaintiff has used its . . . mark since 1979, it offered figures relating to advertising and catalog circulation for the year 2003 only. **Such figures for a single year are not especially meaningful.**” (emphasis added)). Moreover, “[i]t is the duty of a party asserting that its mark is famous to clearly prove it.” *Leading Jewelers Guild*, 82 U.S.P.Q.2d at 1904.

Here, Forest contends that its mark is famous or well-known in the trade, but it supports this assertion only with sales figures and advertising expenditures from a single year (2014), and a claim that the mark has been in use since 2009.²² To the extent this alone is somehow

²² See Motion at p. 18.

sufficient to demonstrate fame under the fifth *DuPont* factor, discovery is needed to show what significance, if any, these figures hold in the relevant trade, so that these figures may be put in context as required by the controlling law (particularly also in view of Forest's misrepresentations of material fact pertaining to the scope of its registration for and use of the SAVELLA mark). (*See* Patel Declaration at ¶ 15). Quite obviously, facts and evidence upon which Forest may rely in support of its alleged "fame" argument are within the possession, custody or control of Forest. (*Id.*).

G. Discovery Related to Sebela's Sixth Affirmative Defense

As admitted by Forest, Sebela's Sixth Affirmative Defense "reserves the right" to challenge Forest's registrations "as further facts are developed through discovery,"²³ yet Forest now argues that this defense should be dismissed *before* affording Sebela the ability to take that discovery. This need is all the more present now in light of Forest's deletion of "neuropathic pain disorders" from its SAVELLA registration, and its misrepresentations of material fact made before the Board concerning the scope of use of its SAVELLA Marks in connection with such (deleted) goods. (*See* Patel Declaration at ¶ 16). Indeed, such misrepresentations raise questions at least as to the scope of enforceability of Sebela's registrations, the salient evidence for which resides within Forest's possession, including, for example, the scope of use of its marks/registrations. (*Id.*). Here again, the requested discovery is required in order to enable Sebela to demonstrate the existence of genuine issues of material fact as to the foregoing. (*Id.*).

²³ *See* Motion at p. 23.

III. CONCLUSION

For the foregoing reasons, Sebela respectfully requests that Forest's Motion for Summary Judgment be denied, and that Sebela be permitted a sixty (60) day period in which to take the requested discovery.

Date: April 30, 2015

Respectfully submitted,

/s/ Ashish D. Patel

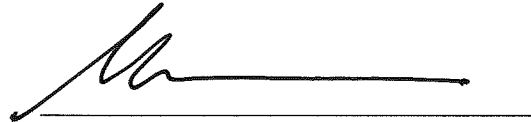
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Attorneys for Applicant

CERTIFICATE OF FILING

I hereby certify that the foregoing *Sebela's Rule 56(d) Response to Forest's Motion for Summary Judgment*, and all attachments and exhibits thereto, are being filed electronically through the United States Patent and Trademark Office's ESTTA electronic filing system on this 30th day of April, 2015.

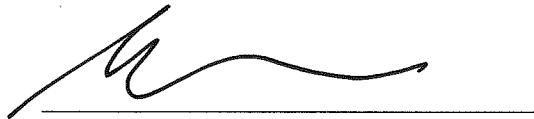


Ashish D. Patel
Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that true and complete copies of *Sebela's Rule 56(d) Response to Forest's Motion for Summary Judgment*, and all attachments and exhibits thereto, are being served on this 30th day of April, 2015, by United States First Class Mail, postage prepaid, on the following:

Christopher Serbagi, Esq.
The Serbagi Law Firm, P.C.
488 Madison Avenue, Suite 1120
New York, New York 10022



Ashish D. Patel
Attorney for Applicant

ATTACHMENT “1”

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re: U.S. Trademark Application Serial No. 86/127,398

Mark: SEBELA

Filing Date: November 22, 2013

Publication Date: April 22, 2014

FOREST LABORATORIES, LLC,)	
)	
Opposer,)	Opposition No.: 91216969
)	
v.)	
)	
SEBELA INTERNATIONAL LIMITED,)	
)	
Applicant.)	

**DECLARATION OF ASHISH D. PATEL IN SUPPORT OF SEBELA’S RULE 56(D)
RESPONSE TO FOREST’S MOTION FOR SUMMARY JUDGMENT**

I, Ashish D. Patel, declare as follows:

1. I am a partner in the law firm of Thompson Hine, LLP, and attorney of record for Sebela International Limited (“Sebela” or “Applicant”). I submit this declaration in support of *Sebela’s Rule 56(d) Response to Forest’s Motion for Summary Judgment* filed contemporaneously herewith. I am familiar with and have personal knowledge of the facts and statements set forth herein.

2. Forest’s Motion for Summary Judgment (“Motion”) was filed on March 31, 2015, nearly two (2) months before the scheduled May 25, 2015 close of discovery.

3. Sebela cannot currently present facts essential to support its opposition to Forest’s Motion. It is believed that evidence needed by Sebela to oppose Forest’s Motion and to thus demonstrate the existence of multiple genuine issues of material fact resides within Forest’s possession, custody or control. However, the filing of Forest’s Motion necessarily suspended discovery prior to its scheduled close, and, thus, absent the Board’s grant of the relief requested,

Sebela will be deprived of evidence required to properly oppose Forest's Motion and to demonstrate the existence of numerous genuine issues of material fact relevant to several *DuPont* factors addressed herein.

***Discovery Pertaining to the Similarity or Dissimilarity
and Nature of the Goods or Services (The Second DuPont Factor)***

4. In support of its Motion, and in support of its contention that the parties' respective goods are related, Forest repeatedly misrepresents material facts to the Board; namely: (1) that U.S. Registration No. 3,658,661, for the SAVELLA mark, covers pharmaceutical preparations for the treatment of "neuropathic pain disorders" in Class 5¹; (2) that the SAVELLA mark has been in continuous and actual use in the United States on or in connection with such pharmaceutical preparations for the treatment of "neuropathic pain disorders" since April 24, 2009²; (3) that the SAVELLA mark is used on pharmaceutical preparations for the treatment of neuropathic pain disorders"³, and (4) that Forest's Class 5 registration for SAVELLA covers pharmaceutical preparations for the treatment of "neuropathic pain disorders"⁴.

5. However, on July 21, 2014 (approximately one (1) month after initiating this Opposition), Forest expressly and permanently deleted "neuropathic pain disorders" from its description of goods in U.S. Registration No. 3,658,661, in a Combined Declaration Under Section 8 & 15 filed in connection therewith – and thus statutorily declared that the SAVELLA mark was no longer in use on or in connection with such goods and that the SAVELLA registration no longer covered such goods. (*See* Exhibits A and B hereto).

¹ *See, e.g.*, Motion at pp. 1, 2.

² *See, e.g.*, Motion at pp. 2, 3, 18.

³ *See, e.g.*, Motion at pp. 1, 2, 13, 15, 20.

⁴ *See, e.g.*, Motion at pp. 1, 2, 13, 15, 20.

6. Discovery into the facts concerning the specific goods on which Forest actually uses its SAVELLA mark is required, as it is fully relevant to an evaluation of the similarity or dissimilarity and nature of the parties' respective goods, and thus to the likelihood of confusion analysis. Forest's misrepresentations as to the scope of its registration and actual use of its SAVELLA mark further compound the need for discovery into the facts and evidence upon which Forest premises its arguments of similarity or relatedness of the parties' respective goods. It is believed that such evidence is within Forest's possession. The requested discovery is therefore required by Sebela to demonstrate the existence of genuine issues of material fact as to this *DuPont* factor.

7. In addition to revealing Forest's actual goods and services,⁵ it is believed that such discovery will further reveal that the SAVELLA mark is not used with a variety of goods and services -- as Forest contends⁶ -- but rather a single, specific product with a specific purpose and nature, advertised and promoted by Forest in its printed materials (Class 16) and on its dedicated website (Class 44), with no ability or opportunity to be confused with Sebela's products. Here again, it is believed that relevant evidence is within Forest's possession. The requested discovery is therefore required by Sebela to demonstrate the existence of genuine issues of material fact as to Forest's contention.

⁵ It is believed that discovery will further reveal that Forest is not using the "Savella and Design" mark (U.S. Registration No. 3,761,078) in connection with any Class 16 or 44 goods or services pertaining to "neuropathic pain disorders", and that this design mark is only used in connection with the advertisement and promotion of Forest's (Class 5) SAVELLA "fibromyalgia" product, via its printed materials (Class 16) and its dedicated website (Class 44).

⁶ See Motion at pp. 20, 21.

8. Furthermore, Forest's allegations that the sale of the parties' respective goods under their respective marks presents risks of "danger"⁷, "cross-prescription"⁸, "accidental substitution"⁹ or "serious consequences"¹⁰ must be tested through discovery (particularly in view of Forest's misrepresentations of material fact, as addressed above), and through which Sebela anticipates that Forest's contentions will be exposed as unfounded. In particular, Sebela requires discovery into facts and evidence pertaining to (1) Forest's actual goods and services, and the nature and purpose of the goods and services (including, for example, the actual scope of use of Forest's SAVELLA Marks/registrations on what appears to be a single product for a single specific purpose), (2) Forest's contentions regarding the sophistication of the doctors or other specialists prescribing or dispensing the parties' respective goods, (3) the actual manner in which Forest's goods are prescribed, dispensed or used, (4) the inability of patients to "choose" between the parties' respective goods, and (5) the actual consequences of any purported mistakes in view of the nature and purpose of the parties' respective goods. It is believed that evidence pertaining to the foregoing, and upon which Forest has premised its arguments, resides in Forest's possession. Discovery into such facts and evidence is required in order to enable Sebela to demonstrate the dissimilarity between the parties' respective goods, and thus the existence of genuine issues of material fact as to this *DuPont* factor, and, ultimately, that this factor favors Sebela, not Forest.

⁷ See Motion at pp. 1, 16, 21.

⁸ See Motion at p. 2.

⁹ See Motion at p. 16.

¹⁰ See Motion at pp. 21.

***Discovery Pertaining to the Similarity or Dissimilarity
of the Marks In Their Entireties (The First DuPont Factor)***

9. Forest's Motion introduces the testimony of Dr. Lisa Davidson.¹¹ However, Dr. Davidson has not previously been disclosed as an expert, and as a consequence of this and the need for relevant discovery outlined in its motion and this declaration, Sebela cannot yet determine the necessity of taking the deposition of this newly-identified expert.

10. Sebela requires discovery from Forest directed to the connotation ascribed to the SAVELLA mark, and the connotation that Forest purports to ascribe to Applicant's SEBELA mark. Sebela expects that this discovery will demonstrate significant dissimilarities in connotation between the parties' respective marks, and, viewing the marks in their entirety (including the distinct visual and phonetic dissimilarities therebetween), that there exists genuine issues of material fact as to this *DuPont* factor. Ultimately, Sebela anticipates that discovery will demonstrate this *DuPont* factor favors Sebela, not Forest. It is believed that the evidence pertaining to the connotation Forest would ascribe to its own mark and to Sebela's mark would reside squarely within Forest's possession, custody and control.

***Discovery Pertaining to the Number and Nature
of Similar Marks in Use on Similar Goods (The Sixth DuPont Factor)***

11. Forest has not advised the Board of material facts; namely: (a) that Forest previously sought to oppose, but withdrew *with prejudice* its opposition of, the REVELLA mark (U.S. Trademark Application No. 85/417,711; Opposition No. 91206078) based on Forest's SAVELLA Marks, and in which opposition Forest opposed all Class 5 goods of the REVELLA mark (*i.e.*, "diagnostic agents, preparations and substances for medical purposes; diagnostic preparations for medical and veterinary use; diagnostic reagents for medicinal use; medical

¹¹ See Motion at p. 9.

diagnostic reagents”), and argued that “[t]he SAVELLA Marks and the Proposed Mark are very similar in ‘sight, sound, and meaning’” and that “[t]he goods and services described in Applicant’s application are closely related to products and services offered by Opposer under the SAVELLA Marks such that consumer confusion is likely to result.” However, Forest withdrew *with prejudice* its opposition of the REVELLA mark, and permitted the REVELLA mark/application to proceed unhindered in Class 5.¹² (*See* Exhibits C-F hereto).

12. Accordingly, discovery is needed to uncover the facts and evidence surrounding any and all of Forest’s prior oppositions of any third-party marks based on a likelihood of confusion with Forest’s SAVELLA Marks, including Forest’s decisions to oppose or to withdraw any such oppositions, any underlying litigations or settlements between those parties (or any other parties) and Forest concerning alleged likelihood of confusion of those parties’ respective marks and Forest’s SAVELLA Marks, any and all agreements, settlement agreements, consent to register agreements, or consent to use agreements therebetween, and, further, Forest’s knowledge of any other third-party uses of, and pending applications or registrations for, marks that Forest deems similar to its SAVELLA Marks and which are used in connection with goods/services that Forest deems similar or related to Forest’s SAVELLA goods/services, as

¹² Forest also opposed the AVELLA INC. and AVELLA HEALTH VIA EXCELLENCE marks (U.S. Trademark Application Nos. 85/606,899 and 85/618,429, respectively; Opposition No. 91209923) based on a likelihood of confusion with Forest’s SAVELLA Marks, and wherein Forest opposed all classes, including the Class 5 goods directed to “drug delivery agents consisting of compounds that facilitate delivery of a wide range of pharmaceuticals; pharmaceutical preparations and substances for the treatment of infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, obesity and cognitive disorders; pharmaceutical preparations and substances for the treatment of viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, psychiatric and immune system related diseases and disorders; pharmaceutical preparations for the treatment of eye diseases and conditions”. Amendments made to the description of goods and services in the applications ultimately led to Forest withdrawing the opposition with prejudice. (*See* Exhibits G-K hereto).

well as any actions or inactions taken by Forest based on such knowledge. Such discovery is further germane to each of the *DuPont* factors at issue here, including the similarity or dissimilarity of the parties' respective marks and goods, and the alleged fame of Forest's SAVELLA Marks. It is believed that facts and evidence pertaining to the foregoing are within Forest's possession, custody or control. The requested discovery is therefore required by Sebela to demonstrate the existence of genuine issues of material fact as to this *DuPont* factor, and, ultimately, that this factor favors Sebela, not Forest.

Discovery Pertaining to the Sophistication of Purchasers (The Fourth DuPont Factor)

13. Although Forest argues that doctors or pharmacists may confuse the parties' respective prescription products,¹³ Sebela believes that discovery will demonstrate that, in addition to having distinctly different natures and purposes, the parties' respective products will be prescribed by doctors specializing in entirely separate and distinct disciplines of medicine, which will, in turn, govern how the parties' respective products are or will be prescribed, administered and used. Sebela requires discovery into these issues and into the bases of Forest's arguments to develop these important distinctions. Here again, it is believed that relevant facts and evidence upon which Forest may rely in support of its argument may be within the possession of Forest. Discovery thereof is required to enable Sebela to demonstrate genuine issues of material fact as to this *DuPont* factor.

Discovery Pertaining to the Variety of Goods on which a Mark is Used or Not Used (The Ninth DuPont Factor)

14. Although Forest argues that it uses the SAVELLA mark "on a variety of goods and services,"¹⁴ Sebela expects that discovery will reveal this conclusory allegation as false.

¹³ See Motion at pp. 16-18.

¹⁴ See Motion at p. 20.

Given that Forest deleted “neuropathic pain disorders” from the goods description of its registration, it is believed that discovery will demonstrate that the SAVELLA mark is limited to a single, specific product for the treatment of fibromyalgia, which is advertised by Forest using its printed materials (Class 16) and its dedicated website (Class 44). Discovery is required in order to enable Sebela to demonstrate the existence of a genuine issue of material fact as to this *DuPont* factor, and, ultimately, that this factor favors Sebela, not Forest.

Discovery Pertaining to the Alleged Fame of Forest’s Mark (The Fifth DuPont Factor)

15. Forest contends that its mark is famous or well-known in the trade, but it supports this assertion only with sales figures and advertising expenditures from a single year (2014), and a claim that the mark has been in use since 2009.¹⁵ To the extent this alone is sufficient to demonstrate fame under the fifth *DuPont* factor, discovery is needed to show what significance, if any, these figures hold in the relevant trade, so that these figures may be put in context as required by the controlling law (particularly also in view of Forest’s misrepresentations of material fact pertaining to the scope of its registration for and use of the SAVELLA mark). It is believed that, facts and evidence upon which Forest may rely in support of its alleged “fame” argument are within the possession, custody or control of Forest.

Discovery Pertaining to Sebela’s Sixth Affirmative Defense

16. As admitted by Forest, Sebela’s Sixth Affirmative Defense “reserves the right” to challenge Forest’s registrations “as further facts are developed through discovery,”¹⁶ yet Forest now argues that this defense should be dismissed before affording Sebela the ability to take that discovery. This need is all the more present now in light of Forest’s deletion of “neuropathic pain disorders” from its SAVELLA registration, and its misrepresentations of material fact made

¹⁵ See Motion at p. 18.

¹⁶ See Motion at p. 23.

before the Board concerning the scope of use of its SAVELLA Marks in connection with such (deleted) goods. Indeed, such misrepresentations raise questions at least as to the scope of enforceability of Sebela's registrations, the salient evidence for which is believed to reside within Forest's possession, including, for example, the scope of use of its marks/registrations. Here again, the requested discovery is required in order to enable Sebela to demonstrate the existence of genuine issues of material fact as to the foregoing.

17. I hereby certify that Exhibits A-K attached hereto are true and correct copies of documents retrieved through the USPTO (via TSDR) website and the TTAB (via TTABVUE) website on April 30, 2015.

The matters stated in this declaration are true and accurate to the best of my personal knowledge. Pursuant to 28 U.S.C. § 1746, I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Dated: April 30, 2015
Atlanta, Georgia

By: _____



Ashish D. Patel
Attorney for Applicant

EXHIBIT “A”


[▲ Collapse All](#)
Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For:	pharmaceutical preparations for the treatment of fibromyalgia [and neuropathic pain disorders]		
International Class(es):	005 - Primary Class	U.S Class(es):	006, 018, 044
Class Status:	ACTIVE		
Basis:	1(a)		
First Use:	Apr. 24, 2009	Use in Commerce:	Apr. 24, 2009

Filed Use:	No	Currently Use:	Yes
Filed ITU:	Yes	Currently ITU:	No
Filed 44D:	No	Currently 44D:	No

Jul. 15, 2008	LAW OFFICE REGISTRATION REVIEW COMPLETED	10231
Jul. 21, 2008	REGISTERED-PRINCIPAL REGISTER	
Jan. 08, 2013	LEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jan. 08, 2013	LEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jul. 21, 2014	LEAS SECTION 8 & 12 RECEIVED	
Aug. 08, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	10082
Aug. 08, 2014	REGISTERED - SEC. 8 (e-18) ACCEPTED & SEC. 12 ACK.	10082
Aug. 08, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 12 - E-MAILED	
Date	Description	Proceeding Number

[Proceedings - Click to Load](#)

Current Location:	TMO LAW OFFICE 110	Date in Location:	Aug. 08, 2014
File Location			
TM Staff Information - None			

Affidavit of Incontestability:	Section 12 - Accepted
Affidavit of Continued Use:	Section 8 - Accepted

Jun. 22, 2001	NEW APPLICATION ENTERED IN TRAM	
Sep. 25, 2001	ASSIGNED TO EXAMINER	18313
Sep. 27, 2001	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 29, 2001	ASSIGNED TO FIE	10231
Oct. 29, 2001	LAW OFFICE PUBLICATION REVIEW COMPLETED	10231
Nov. 14, 2001	NOTICE OF PUBLICATION	
Dec. 04, 2001	PUBLISHED FOR OPPOSITION	
Feb. 20, 2008	NOA MAILED - SON REQUIRED FROM APPLICANT	
Jul. 31, 2008	TEAS EXTENSION RECEIVED	
Jul. 31, 2008	EXTENSION 1 FILED	08102
Jul. 31, 2008	EXTENSION 1 GRANTED	08102
Feb. 20, 2008	TEAS EXTENSION RECEIVED	
Feb. 20, 2008	EXTENSION 2 FILED	08102
Feb. 20, 2008	EXTENSION 2 GRANTED	08102
Apr. 29, 2008	TEAS STATEMENT OF USE RECEIVED	
May 18, 2008	CASE ASSIGNED TO INTENT TO USE PARALEGAL	10202
Apr. 29, 2008	USE AMENDMENT FILED	10202
May 18, 2008	STATEMENT OF USE PROCESSING COMPLETE	10202
Jun. 08, 2008	ALLOWED PRINCIPAL REGISTER - SON ACCEPTED	

EXHIBIT “B”

Combined Declaration of Use and Incontestability under Sections 8 & 15

The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	3658661
REGISTRATION DATE	07/21/2009
SERIAL NUMBER	77211766
MARK SECTION	
MARK	SAVELLA
ATTORNEY SECTION (no change)	
NAME	Christopher Serbagi
FIRM NAME	THE SERBAGI LAW FIRM
STREET	488 MADISON AVE STE 1120
CITY	NEW YORK
STATE	New York
POSTAL CODE	10022-5719
COUNTRY	United States
PHONE	212-593-2112
FAX	212-308-8582
EMAIL	ptoemails@earthlink.net
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
CORRESPONDENCE SECTION (no change)	
NAME	Christopher Serbagi
FIRM NAME	THE SERBAGI LAW FIRM
STREET	488 MADISON AVE STE 1120
CITY	NEW YORK
STATE	New York

POSTAL CODE	10022-5719
COUNTRY	United States
PHONE	212-593-2112
FAX	212-308-8582
EMAIL	ptoemails@earthlink.net;david@serbagilaw.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	005
GOODS OR SERVICES TO BE DELETED	and neuropathic pain disorders
GOODS OR SERVICES IN USE IN COMMERCE	pharmaceutical preparations for the treatment of fibromyalgia
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT16\772\117\77211766\xml3\ 8150002.JPG
SPECIMEN DESCRIPTION	A depiction of Registrant's mark on its product
OWNER SECTION (current)	
NAME	Forest Laboratories, Inc.
STREET	909 Third Avenue
CITY	New York
STATE	New York
ZIP/POSTAL CODE	10022
COUNTRY	United States
OWNER SECTION (proposed)	
NAME	Forest Laboratories, Inc.
STREET	909 Third Avenue
CITY	New York
STATE	New York
ZIP/POSTAL CODE	10022
COUNTRY	United States
PHONE	212-593-2112
FAX	212-308-8582

EMAIL	ptoemails@earthlink.net
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
LEGAL ENTITY SECTION (current)	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Delaware
PAYMENT SECTION	
NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	300
TOTAL FEE PAID	300
SIGNATURE SECTION	
SIGNATURE	/christopher serbagi/
SIGNATORY'S NAME	Christopher Serbagi
SIGNATORY'S POSITION	Attorney of record NY bar member
DATE SIGNED	07/21/2014
SIGNATORY'S PHONE NUMBER	212-593-2112
PAYMENT METHOD	CC
FILING INFORMATION	
SUBMIT DATE	Mon Jul 21 09:24:06 EDT 2014
TEAS STAMP	USPTO/S08N15-71.249.131.1 00-20140721092406439170-3 658661-500bd72de9d8ace26f 13866716c2476c8d6697b5a1d 8b95c75b7c73a3912cc38d-CC -7439-2014072109111607230 3

**Combined Declaration of Use and Incontestability under Sections 8 & 15
To the Commissioner for Trademarks:**

REGISTRATION NUMBER: 3658661

REGISTRATION DATE: 07/21/2009

MARK: SAVELLA

The owner, Forest Laboratories, Inc., a corporation of Delaware, having an address of
909 Third Avenue
New York, New York 10022
United States

is filing a Combined Declaration of Use and Incontestability under Sections 8 & 15.

For International Class 005, this filing does **NOT** cover the following goods or services for this specific class listed in the registration, and these goods or services are to be permanently **deleted** from the registration: and neuropathic pain disorders

The mark is in use in commerce on or in connection with the following goods or services listed in the existing registration for this specific class: pharmaceutical preparations for the treatment of fibromyalgia

For the remaining goods or services, the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with these goods or services. Also, no final decision adverse to the owner's claim of ownership of such mark for those goods or services exists, or to the owner's right to register the same or to keep the same on the register; and, no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exists.

The owner is submitting one(or more) specimen(s) for this class showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) A depiction of Registrant's mark on its product.

[Specimen File1](#)

A fee payment in the amount of \$300 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

Declaration

The mark is in use in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The mark has been in continuous use in commerce for five consecutive years after the date of registration, or the date of publication under 15 U.S.C. Section 1062(c), and is still in use in commerce on or in connection with all goods/services listed in the existing registration. There has been no final decision adverse to the owner's claim of ownership of

such mark for such goods/services, or to the owner's right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the United States Patent and Trademark Office or in a court.

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this submission, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Signature: /christopher serbagi/ Date: 07/21/2014
Signatory's Name: Christopher Serbagi
Signatory's Position: Attorney of record NY bar member
Signatory's Phone Number: 212-593-2112

Mailing Address:
THE SERBAGI LAW FIRM
488 MADISON AVE STE 1120
NEW YORK, New York 10022-5719

Serial Number: 77211766
Internet Transmission Date: Mon Jul 21 09:24:06 EDT 2014
TEAS Stamp: USPTO/S08N15-71.249.131.100-201407210924
06439170-3658661-500bd72de9d8ace26f13866
716c2476c8d6697b5a1d8b95c75b7c73a3912cc3
8d-CC-7439-20140721091116072303

Rx only

NDC 0456-1512-60

Savella[®]

(milnacipran HCl) Tablets

60 Tablets

12.5 mg

Dispense the accompanying Medication
Guide to each patient.



FOREST PHARMACEUTICALS, INC.

Subsidiary of Forest Laboratories, Inc.
St. Louis, Missouri 63045

ROUTING SHEET TO POST REGISTRATION (PRU)**Registration Number:** 3658661**Serial Number:** 77211766**RAM Sale Number:** 3658661**RAM Accounting Date:** 20140721**Total Fees:** \$300

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Number of Classes Paid</u>	<u>Total Fee</u>
\$8 affidavit	7205	20140721	\$100	1	1	\$100
\$15 affidavit	7208	20140721	\$200	1	1	\$200

Physical Location: - UNKNOWN

Lost Case Flag: False

In TICRS (AM-FLG-IN-TICRS): True

Transaction Date: 20140721

EXHIBIT “C”



▲ Collapse All

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

	For:	Diagnostic agents, preparations and substances for medical purposes; Diagnostic preparations f Diagnostic reagents for medicinal use; Medical diagnostic reagents		
	International Class(es):	005 - Primary Class	U.S Class(es):	006, 018, 04
	Class Status:	ACTIVE		
	Basis:	1(b)		

	Filed Use:	No		Currently Use:	No
	Filed ITU:	Yes		Currently ITU:	Yes
	Filed 44D:	No		Currently 44D:	No
	Filed 44E:	No		Currently 44E:	No

Oct. 01, 2014	EXTENSION 4 GRANTED	11034
	MAILED	
Oct. 08, 2014	NOTICE OF APPROVAL OF EXTENSION REQUEST E-	
Apr. 01, 2012	LEAS EXTENSION RECEIVED	
Apr. 01, 2012	EXTENSION 2 FILED	11034
Apr. 14, 2012	EXTENSION 2 GRANTED	11034
	MAILED	
Apr. 12, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST E-	
Date	Description	Proceeding Number

Feb. 15, 2011	NEW APPLICATION ENTERED IN TRAM	
	TRAM	
Feb. 13, 2011	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN	
Feb. 23, 2011	TEAS VOLUNTARY AMENDMENT RECEIVED	
	ASSIGNED	
Feb. 23, 2011	TEAS AMENDMENT ENTERED BEFORE ATTORNEY	88888
Dec. 08, 2011	ASSIGNED TO EXAMINER	88555
Dec. 11, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER	
Dec. 28, 2011	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jan. 15, 2012	PUBLISHED FOR OPPOSITION	
	MAILED	
Jan. 15, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-	
Jan. 18, 2012	EXTENSION OF TIME TO OPPOSE RECEIVED	
Jul. 12, 2012	OPPOSITION INSTITUTED NO. 888888	508018
Aug. 25, 2012	OPPOSITION DISMISSED NO. 888888	508018
Aug. 25, 2012	OPPOSITION TERMINATED NO. 888888	508018
Aug. 25, 2012	TAB RELEASE CASE TO TRADEMARKS	508018
Oct. 08, 2012	NOA E-MAILED - SON RECEIVED FROM APPLICANT	
Mar. 22, 2013	TEAS EXTENSION RECEIVED	
Mar. 22, 2013	EXTENSION 1 FILED	88182
Mar. 22, 2013	EXTENSION 1 GRANTED	88182
	MAILED	
Mar. 28, 2013	NOTICE OF APPROVAL OF EXTENSION REQUEST E-	
Oct. 02, 2013	TEAS EXTENSION RECEIVED	
Nov. 15, 2013	CASE ASSIGNED TO INTENT TO USE PARALEGAL	11034
Oct. 02, 2013	EXTENSION 2 FILED	11034
Nov. 22, 2013	EXTENSION 2 GRANTED	11034
	MAILED	
Nov. 23, 2013	NOTICE OF APPROVAL OF EXTENSION REQUEST E-	
Apr. 03, 2014	TEAS EXTENSION RECEIVED	
Apr. 03, 2014	EXTENSION 3 FILED	11034
Apr. 01, 2014	EXTENSION 3 GRANTED	11034
	MAILED	
Apr. 11, 2014	NOTICE OF APPROVAL OF EXTENSION REQUEST E-	
Oct. 02, 2014	TEAS EXTENSION RECEIVED	
Oct. 02, 2014	EXTENSION 4 FILED	11034

TM Staff Information**TM Attorney:** BUCHANAN WILL, NORA**Law Office Assigned:** LAW OFFICE**File Location****Current Location:** INTENT TO USE SECTION**Date in Location:** Nov. 12, 2015**▼ Proceedings - Click to Load**

EXHIBIT “D”

ESTTA Tracking number: **ESTTA483435**

Filing date: **07/15/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Forest Laboratories, Inc.
Granted to Date of previous extension	07/15/2012
Address	909 Third Avenue New York, NY 10022 UNITED STATES

Correspondence information	Forest Laboratories, Inc. 909 Third Avenue New York, NY 10022 UNITED STATES madis48@earthlink.net Phone:212-593-2112
----------------------------	--

Applicant Information

Application No	85417711	Publication date	01/17/2012
Opposition Filing Date	07/15/2012	Opposition Period Ends	07/15/2012
Applicant	Novartis AG CH-4002 Basel, SWITZERLAND		

Goods/Services Affected by Opposition


Class 005. All goods and services in the class are opposed, namely: Diagnostic agents, preparations and substances for medical purposes; Diagnostic preparations for medical and veterinary use; Diagnostic reagents for medicinal use; Medical diagnostic reagents
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3658661	Application Date	06/21/2007
Registration Date	07/21/2009	Foreign Priority Date	NONE
Word Mark	SAVELLA		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 2009/04/24 First Use In Commerce: 2009/04/24 pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders

U.S. Registration No.	3761078	Application Date	08/03/2009
Registration Date	03/16/2010	Foreign Priority Date	NONE
Word Mark	SAVELLA		
Design Mark			
Description of Mark	The mark consists of "SAVELLA" followed by two curved lines on top of three curved lines.		
Goods/Services	<p>Class 016. First use: First Use: 2009/05/17 First Use In Commerce: 2009/05/17 printed matter, namely, brochures, pamphlets, posters, newsletters, promotional materials, patient educational materials, all concerning the treatment of fibromyalgia and neuropathic pain disorders</p> <p>Class 044. First use: First Use: 2009/01/15 First Use In Commerce: 2009/01/15 medical informational services, namely, providing health information in the field of fibromyalgia and neuropathic pain disorders via a global computer network</p>		

Attachments	77211766#TMSN.jpeg (1 page)(bytes) 77795756#TMSN.jpeg (1 page)(bytes) REVELLA Notice of Opposition.pdf (4 pages)(82576 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/christopher Serbagi/
Name	Forest Laboratories, Inc.
Date	07/15/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 85,417,711
Mark: REVELLA

FOREST LABORATORIES, INC.,)	
)	
Opposer,)	OPPOSITION NO.:
)	
v.)	
)	
)	
NOVARTIS AG CORPORATION)	
SWITZERLAND)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, Forest Laboratories, Inc., a Delaware corporation located and doing business at 909 Third Avenue, New York, New York 10022, believes that it will be damaged by registration of the mark shown in Serial No. 85/417,711, which was published in the *Official Gazette* on January 17, 2012, and hereby opposed the same.

As grounds for the opposition, Opposer alleges that:

1. Applicant filed intent-to-use Application Serial No. 85/417,711 on or about September 8, 2011 to register the mark REVELLA in connection with “Diagnostic agents, preparations and substances for medical purposes; Diagnostic preparations for medical and veterinary use; Diagnostic reagents for medicinal use; Medical diagnostic reagents” in Class 5 (the “Proposed Mark”).
2. Opposer will be damaged by the registration of the Proposed Mark.

3. Opposer is the owner of the following U.S. registrations: SAVELLA, Reg. No. 3,658,661, filed on June 21, 2007 and registered on July 21, 2009 for “Pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders” in Class 5 and SAVELLA and Design, Reg. No. 3,761,078, filed on August 3, 2009 and registered on March 16, 2010 for “Printed matter, namely brochures, pamphlets, posters, newsletters, promotional materials, and patient educational materials, all concerning the treatment of fibromyalgia and neuropathic pain disorders” in Class 16 and “Medical information services, namely, providing health information in the field of fibromyalgia and neuropathic pain disorders via a global computer network” in Class 44 (collectively, the “SAVELLA Marks”). These registrations are valid, subsisting, and in full force and effect, and constitute evidence of the validity of the SAVELLA Marks and of Opposer’s exclusive right to use them on the goods and services identified in the registrations.

4. The SAVELLA Marks are in use in connection with an FDA-approved prescription pharmaceutical, and have been the subject of significant marketing efforts.

5. The SAVELLA Marks and the Proposed Mark are very similar in “sight, sound, and meaning.” The goods and services described in Applicant’s application are closely related to products and services offered by Opposer under the SAVELLA Marks such that consumer confusion is likely to result.

6. Opposer’s SAVELLA Marks have priority because Opposer filed its applications for those marks on (June 21, 2007 and August 3, 2009) before any priority date that Applicant can claim relating to the Proposed Mark

7. WHEREFORE, Opposer requests that the Board sustain this Opposition and refuse registration of the mark REVELLA (Serial No. 85/417,711) in Class 5.

THE SERBAGI LAW FIRM, P.C.
Attorney for Forest Laboratories, Inc.

Dated: July 15, 2011
New York, New York

/Christopher Serbagi/
Christopher Serbagi
David Marcus
488 Madison Avenue, Suite 1120
New York, New York 10022
Tele: (212) 593-2112
Fax: (212) 308-8582

CERTIFICATE OF SERVICE

I certify that on July 15, 2012, I served a copy of the attached Notice of Opposition by causing a true copy thereof to be delivered by electronic communication and Federal Express to Applicant's attorney of record in an envelope addressed as follows:

Maury M. Tepper, III, Esq.
TEPPER & EYSTER, PLLC
3724 Benson Dr.
Raleigh, N.C. 27609-7321

/Christopher Serbagi/
Christopher Serbagi

EXHIBIT “E”

ESTTA Tracking number: **ESTTA490741**

Filing date: **08/23/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206078
Party	Plaintiff Forest Laboratories, Inc.
Correspondence Address	Forest Laboratories, Inc. 909 Third Avenue New York, NY 10022 UNITED STATES madis48@earthlink.net
Submission	Withdrawal of Opposition
Filer's Name	Christopher Serbagi
Filer's e-mail	madis48@earthlink.net, david@serbagilaw.com
Signature	/Christopher Serbagi/
Date	08/23/2012
Attachments	Notice of Withdrawal PDF.pdf (1 page)(55280 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Serial No. 85/417,711

Filed: September 8, 2011

Mark: REVELLA

Proceeding No. 91206078

Forest Laboratories, Inc.

v.

Novartis AG.

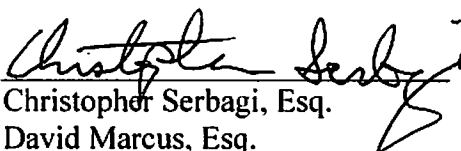
WITHDRAWAL OF OPPOSITION PROCEEDING WITH CONSENT

Opposer Forest Laboratories, Inc. hereby withdraws this action with prejudice with the consent of the Applicant, Novartis AG.

Dated: New York, New York
August 23, 2012

Respectfully Submitted,

THE SERBAGI LAW FIRM, P.C.

By: 
Christopher Serbagi, Esq.
David Marcus, Esq.
488 Madison Avenue, Suite 1120
New York, New York 11201
Tele: (212) 593-2112
Fax: (212) 308-8582

Attorney for Opposer Forest Laboratories, Inc.

EXHIBIT ‘F’

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

nmt

Mailed: August 27, 2012

Opposition No. 91206078

Forest Laboratories, Inc.

v.

Novartis AG

On August 23, 2012, opposer filed a withdrawal of the opposition with prejudice. In view thereof, the opposition is dismissed with prejudice.¹

***By the Trademark Trial
and Appeal Board***

¹Opposer's withdrawal does not indicate proof of service as required by Trademark Rule 2.119. In order to expedite this matter, a copy of said withdrawal is forwarded herewith to counsel for applicant.

EXHIBIT “G”

[▲ Collapse All](#)**Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [.] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

	For:	Mail order pharmacy services; Pharmaceutical services, namely, processing online and telephonic central fill pharmacies; Retail pharmacy services; Retail veterinary pharmacy services	
	International Class(es):	035 - Primary Class	U.S Class(es): 100, 101, 102
	Class Status:	ACTIVE	
	Basis:	1(b)	
	For:	Medical and pharmaceutical consultation in association with a pharmacy's practice; pharmacists' association with a pharmacy's practice	
	International Class(es):	044 - Primary Class	U.S Class(es): 100, 101
	Class Status:	ACTIVE	
	Basis:	1(b)	

**Attorney of Record**

Attorney Name:	/Sean D. Johnson/	Docket Number:	124.0003
Attorney Primary Email Address:	docketing@ifllaw.com	Attorney Email Authorized:	Yes

Correspondent

Correspondent Name/Address:	/Sean D. Johnson/ Ingrassia, Fisher & Lorenz, PC 7010 E. Cochise Road Scottsdale, ARIZONA 85253 UNITED STATES		
Phone:	(480) 385-5060	Fax:	(480) 385-50
Correspondent e-mail:	docketing@ifllaw.com	Correspondent e-mail Authorized:	Yes

Domestic Representative - Not Found

Date	Description	Proceeding Number
Mar. 03, 2015	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	

Apr. 23, 2015	NEW APPLICATION ENTERED IN TRAM	
	TRAM	
May 01, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN	
Aug. 08, 2015	ASSIGNED TO EXAMINER	81088
Aug. 10, 2015	EXAMINER'S AMENDMENT -WRITTEN	81088
Aug. 10, 2015	EXAMINER'S AMENDMENT E-MAILED	8358
Aug. 10, 2015	NOTIFICATION OF EXAMINER'S AMENDMENT E-MAILED	8358
Aug. 10, 2015	EXAMINER'S AMENDMENT ENTERED	88888
Aug. 11, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 21, 2015	ASSIGNED TO FIE	11315
Aug. 22, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	11315
Sep. 02, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Sep. 22, 2015	PUBLISHED FOR OPPOSITION	
	MAILED	
Sep. 22, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-	
Sep. 28, 2015	EXTENSION OF TIME TO OPPOSE RECEIVED	
Mar. 22, 2013	OPPOSITION INSTITUTED NO. 888888	508853
Jul. 14, 2013	PAPER RECEIVED	
Jul. 03, 2013	OPPOSITION DISMISSED NO. 888888	508853
Jul. 03, 2013	OPPOSITION TERMINATED NO. 888888	508853
Jul. 03, 2013	TTAB RELEASE CASE TO TRADEMARKS	508853
Aug. 15, 2013	LEADS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 20, 2013	NOV E-MAILED - SON RECEIVED FROM APPLICANT	
Feb. 20, 2014	LEADS EXTENSION RECEIVED	
Mar. 14, 2014	CASE ASSIGNED TO INTENT TO USE PARALEGAL	88530
Feb. 20, 2014	EXTENSION 1 FILED	88530
Mar. 13, 2014	EXTENSION 1 GRANTED	88530
Mar. 18, 2014	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Aug. 20, 2014	LEADS EXTENSION RECEIVED	
Aug. 20, 2014	EXTENSION 2 FILED	88530
Aug. 22, 2014	EXTENSION 2 GRANTED	88530
Aug. 28, 2014	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Feb. 18, 2012	LEADS EXTENSION RECEIVED	
Feb. 18, 2012	EXTENSION 3 FILED	88530
Mar. 05, 2012	EXTENSION 3 GRANTED	88530

TM Staff Information**TM Attorney:** MCDOWELL, MATTHEW J**Law Office Assigned:** LAW OFFICE**File Location****Current Location:** INTENT TO USE SECTION**Date in Location:** Mar. 14, 2014**▼ Proceedings - Click to Load**

EXHIBIT “H”



Collapse All

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [.] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Mail order pharmacy services; Pharmaceutical services, namely, processing online and telephonic central fill pharmacies; Retail pharmacy services; Retail veterinary pharmacy services	
International Class(es): 035 - Primary Class	U.S Class(es): 100, 101, 102
Class Status: ACTIVE	
Basis: 1(b)	
For: Medical and pharmaceutical consultation in association with a pharmacy's practice; pharmacists'	

**Attorney of Record**

Attorney Name:	Sean D. Johnson	Docket Number:	124.0004
Attorney Primary Email Address:	docketing@ifllaw.com	Attorney Email Authorized:	Yes

Correspondent

Correspondent Name/Address:	Sean D. Johnson Ingrassia Fisher & Lorenz, PC 7010 E. Cochise Road Scottsdale, ARIZONA 85253 UNITED STATES		
Phone:	(480) 385-5060	Fax:	(480) 385-50
Correspondent e-mail:	docketing@ifllaw.com	Correspondent e-mail Authorized:	Yes

Domestic Representative - Not Found

May 12, 2015	NOTICE OF DESIGN SEARCH CODE MAILED	
Aug. 08, 2015	ASSIGNED TO EXAMINER	81000
Aug. 10, 2015	EXAMINER'S AMENDMENT -WRITTEN	81000
Aug. 10, 2015	EXAMINER'S AMENDMENT E-MAILED	0358
Aug. 10, 2015	NOTIFICATION OF EXAMINER'S AMENDMENT E-MAILED	0358
Aug. 10, 2015	EXAMINER'S AMENDMENT ENTERED	88888
Aug. 11, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 21, 2015	ASSIGNED TO FIE	11315
Aug. 23, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	11315
Feb. 02, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Feb. 22, 2015	PUBLISHED FOR OPPOSITION	
Feb. 22, 2015	MAILED	
Feb. 22, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-	
Feb. 20, 2015	EXTENSION OF TIME TO OPPOSE RECEIVED	
Mar. 22, 2013	OPPOSITION INSTITUTED NO. 000000	500053
Jul. 14, 2013	PAPER RECEIVED	
Jul. 01, 2013	OPPOSITION DISMISSED NO. 000000	500053
Jul. 01, 2013	OPPOSITION TERMINATED NO. 000000	500053
Jul. 01, 2013	TRAB RELEASE CASE TO TRADEMARKS	500053
Aug. 15, 2013	LEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 30, 2013	NOA E-MAILED - SON RECEIVED FROM APPLICANT	
Feb. 30, 2014	LEAS EXTENSION RECEIVED	
Mar. 14, 2014	CASE ASSIGNED TO INTENT TO USE PARALEGAL	00530
Feb. 30, 2014	EXTENSION 1 FILED	00530
Mar. 11, 2014	EXTENSION 1 GRANTED	00530
Mar. 18, 2014	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Aug. 30, 2014	LEAS EXTENSION RECEIVED	
Aug. 30, 2014	EXTENSION 2 FILED	00530
Aug. 22, 2014	EXTENSION 2 GRANTED	00530
Aug. 20, 2014	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Feb. 10, 2012	LEAS EXTENSION RECEIVED	
Feb. 10, 2012	EXTENSION 3 FILED	00530
Mar. 05, 2012	EXTENSION 3 GRANTED	00530
Mar. 03, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Date	Description	Proceeding Number

May 14, 2012

NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM

May 10, 2012

NEW APPLICATION ENTERED IN TRAM

**TM Staff Information****TM Attorney:** MCDOWELL, MATTHEW J**Law Office Assigned:** LAW OFFICE**File Location****Current Location:** INTENT TO USE SECTION**Date in Location:** Mar. 14, 2014**▼ Proceedings - Click to Load**

EXHIBIT “I”

ESTTA Tracking number: **ESTTA528527**

Filing date: **03/25/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Forest Laboratories, Inc.
Granted to Date of previous extension	03/24/2013
Address	909 Third Avenue New York, NY 10022 UNITED STATES
Attorney information	Christopher Serbagi The Serbagi Law Firm, P.C. 488 Madison AvenueSte 1120 New York, NY 10022 UNITED STATES ptoemails@earthlink.net, madis48@earthlink.net, david@serbagilaw.com

Applicant Information

Application No	85606899	Publication date	09/25/2012
Opposition Filing Date	03/25/2013	Opposition Period Ends	03/24/2013
Applicant	APOTHECARY HOLDINGS, INC. 1606 W. Whispering Wind Drive Phoenix, AZ 85085 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 005.</p> <p>All goods and services in the class are opposed, namely: Drug delivery agents consisting of compounds that facilitate delivery of a wide range of pharmaceuticals; Pharmaceutical preparations and substances for the treatment of infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, obesity and cognitive disorders; Pharmaceutical preparations and substances for the treatment of viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, psychiatric and immune system related diseases and disorders; Pharmaceutical preparations for the treatment of eye diseases and conditions</p>
<p>Class 035.</p> <p>All goods and services in the class are opposed, namely: Mail order pharmacy services; Pharmaceutical services, namely, processing online and telephone prescription orders in retail and central fill pharmacies; Retail pharmacy services; Retail veterinary pharmacy services</p>
<p>Class 044.</p> <p>All goods and services in the class are opposed, namely: Medical and pharmaceutical consultation; Pharmacists' services to make up prescriptions</p>

Applicant Information

Application No	85618429	Publication date	09/25/2012
Opposition Filing Date	03/25/2013	Opposition Period Ends	
Applicant	APOTHECARY HOLDINGS, INC. 1606 W. Whispering Wind Drive Phoenix, AZ 85085 UNITED STATES		


Goods/Services Affected by Opposition

<p>Class 005. All goods and services in the class are opposed, namely: Drug delivery agents consisting of compounds that facilitate delivery of a wide range of pharmaceuticals; Pharmaceutical preparations and substances for the treatment of infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, obesity and cognitive disorders; Pharmaceutical preparations and substances for the treatment of viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, psychiatric and immune system related diseases and disorders; Pharmaceutical preparations for the treatment of eye diseases and conditions</p>
<p>Class 035. All goods and services in the class are opposed, namely: Mail order pharmacy services; Pharmaceutical services, namely, processing online and telephone prescription orders in retail and central fill pharmacies; Retail pharmacy services; Retail veterinary pharmacy services</p>
<p>Class 044. All goods and services in the class are opposed, namely: Medical and pharmaceutical consultation; Pharmacists' services to make up prescriptions</p>


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3658661	Application Date	06/21/2007
Registration Date	07/21/2009	Foreign Priority Date	NONE
Word Mark	SAVELLA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2009/04/24 First Use In Commerce: 2009/04/24		

	pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders
--	--

U.S. Registration No.	3761078	Application Date	08/03/2009
Registration Date	03/16/2010	Foreign Priority Date	NONE
Word Mark	SAVELLA		
Design Mark			
Description of Mark	The mark consists of "SAVELLA" followed by two curved lines on top of three curved lines.		
Goods/Services	<p>Class 016. First use: First Use: 2009/05/17 First Use In Commerce: 2009/05/17 printed matter, namely, brochures, pamphlets, posters, newsletters, promotional materials, patient educational materials, all concerning the treatment of fibromyalgia and neuropathic pain disorders</p> <p>Class 044. First use: First Use: 2009/01/15 First Use In Commerce: 2009/01/15 medical informational services, namely, providing health information in the field of fibromyalgia and neuropathic pain disorders via a global computer network</p>		

Attachments	77211766#TMSN.jpeg (1 page)(bytes) 77795756#TMSN.jpeg (1 page)(bytes) AVELLA Notice of Opposition.pdf (4 pages)(85798 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/christopher serbagi/
Name	Christopher Serbagi
Date	03/25/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 85,606,899
Mark: AVELLA, INC. and Serial No. 85/618,429
Mark: AVELLA HEALTH VIA EXCELLENCE

FOREST LABORATORIES, INC.,)	
)	
Opposer,)	OPPOSITION NO.:
)	
v.)	
)	
)	
APOTHECARY HOLDINGS, INC.)	
)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, Forest Laboratories, Inc., a Delaware corporation located and doing business at 909 Third Avenue, New York, New York 10022, believes that it will be damaged by registration of the mark shown in Serial Nos. 85/606,899 and 85/618,429, which were published in the *Official Gazette* on September 25, 2012, and hereby opposes the same.

As grounds for the opposition, Opposer alleges that:

1. On or about May 7, 2012, Applicant filed intent-to-use Applications for the marks AVELLA, INC. (Serial No. 85/606,899) and AVELLA HEALTH VIA EXCELLENCE (Serial No. 85/618,429), both, respectively, for “Drug delivery agents consisting of compounds that facilitate delivery of a wide range of pharmaceuticals; pharmaceutical preparations and substances for the treatment of infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, obesity and cognitive disorders; pharmaceutical preparations and

substances for the treatment of viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, psychiatric and immune system related diseases and disorders; pharmaceutical preparations for the treatment of eye diseases and conditions,” in Class 5, for “Mail order pharmacy services; pharmaceutical services, namely, processing online and telephone prescription orders in retail and central fill pharmacies; retail pharmacy services; Retail veterinary pharmacy services,” in class 35, and for “Medical and pharmaceutical consultation; pharmacists' services to make up prescriptions,” in Class 35 (the “Proposed Marks”).

2. Opposer will be damaged by the registration of the Proposed Marks.

3. Opposer is the owner of the following United States registrations:

SAVELLA, Reg. No. 3,658,661, filed on June 21, 2007 and registered on July 21, 2009 for “Pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders” in Class 5 and SAVELLA and Design, Reg. No. 3,761,078, filed on August 3, 2009 and registered on March 16, 2010 for “Printed matter, namely brochures, pamphlets, posters, newsletters, promotional materials, and patient educational materials, all concerning the treatment of fibromyalgia and neuropathic pain disorders” in Class 16 and “Medical information services, namely, providing health information in the field of fibromyalgia and neuropathic pain disorders via a global computer network” in Class 44 (collectively, the “SAVELLA Marks”).

These registrations are valid, subsisting, and in full force and effect, and constitute evidence of the validity of the SAVELLA Marks and of Opposer’s exclusive right to use them on the goods and services identified in the registrations.

4. The SAVELLA Marks are in use in connection with an FDA-approved prescription pharmaceutical, and have been the subject of significant marketing efforts.

5. The SAVELLA Marks and the Proposed Marks are very similar in “sight, sound, and meaning.” The goods and services described in Applicant’s application are closely related to products and services offered by Opposer under the SAVELLA Marks such that consumer confusion is likely to result.

6. Opposer’s SAVELLA Marks have priority because Opposer filed its applications for those marks on (June 21, 2007 and August 3, 2009) before any priority date that Applicant can claim relating to the Proposed Mark

7. WHEREFORE, Opposer requests that the Board sustain this Opposition and refuse registration of the proposed Marks AVELLA, INC. (Serial No. 85/606,899) and AVELLA HEALTH VIA EXCELLENCE (Serial No. 85/618,429).

THE SERBAGI LAW FIRM, P.C.
Attorney for Forest Laboratories, Inc.

Dated: March 25, 2013
New York, New York

/Christopher Serbagi/
Christopher Serbagi
488 Madison Avenue, Suite 1120
New York, New York 10022
Tele: (212) 593-2112
Fax: (212) 308-8582

CERTIFICATE OF SERVICE

I certify that on March 25, 2013, I served a copy of the attached Notice of Opposition by causing a true copy thereof to be delivered by electronic communication and Federal Express to Applicant's attorney in an envelope addressed as follows:

Sean D. Johnson, Esq.
Ingrassia, Fisher & Lorenz PC
7010 E. Cochise Rd.
Scottsdale, Arizona 85253-1406

And to Applicant as follows:

Apothecary Holdings, Inc.
1606 W. Whispering Wind Dr.
Phoenix, Arizona 85085-1322

/Christopher Serbagi/
Christopher Serbagi

EXHIBIT “J”

ESTTA Tracking number: **ESTTA544218**

Filing date: **06/20/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209923
Party	Plaintiff Forest Laboratories, Inc.
Correspondence Address	CHRISTOPHER SERBAGI THE SERBAGI LAW FIRM PC 488 MADISON AVENUE, STE 1120 NEW YORK, NY 10022 UNITED STATES christopher@serbagilaw.com
Submission	Withdrawal of Opposition
Filer's Name	Christopher Serbagi
Filer's e-mail	christopher@serbagilaw.com
Signature	/Christopher Serbagi/
Date	06/20/2013
Attachments	Withdrawal of Opposition_AVELLA.pdf(56910 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Serial No. 85/606,899

Filed: April 24, 2012

Mark: AVELLA INC.

Proceeding No. 91209923

Forest Laboratories, Inc.

v.

Apothecary Holdings, Inc.

AKA The Apothecary Shops

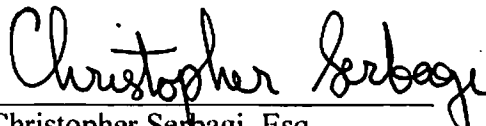
WITHDRAWAL OF OPPOSITION PROCEEDING WITH CONSENT

Opposer Forest Laboratories, Inc. hereby withdraws this action with prejudice with the consent of the Applicant, Apothecary Holdings, Inc.

Dated: New York, New York
June 20, 2013

Respectfully Submitted,

THE SERBAGI LAW FIRM, P.C.

By: 

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Attorney for Opposer Forest Laboratories, Inc.

EXHIBIT “K”

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

kk

Mailed: July 7, 2013

Opposition No. 91209923

Forest Laboratories, Inc.

v.

Apothecary Holdings, Inc.
AKA The Apothecary Shops

On June 14, 2013, the Board approved the amendment to applicant's identification of services in application Serial Nos. 85606899 and 85618429, and allowed opposer time in which to file a withdrawal of the opposition.

On June 20, 2013, opposer filed a withdrawal of the opposition with prejudice.¹ In view thereof, the opposition is dismissed with prejudice.

***By the Trademark Trial
and Appeal Board***

¹ It is noted that opposer's filing fails to include a certificate of service. Future filings must comply with the service requirements in Trademark Rule 2.119 and TBMP Section 113. The Board may decline to consider future non-compliant filings.